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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,679	05/17/2002	Kurt Weiblen	10191/2222	6200
26646	7590	11/04/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			KACKAR, RAM N	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,679

Applicant(s)

WEIBLEN ET AL.

Examiner

Ram N Kackar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. First process step dependent covering element and a second process step dependent covering element are indefinite since they are claimed to be related to an undefined process step with an undefined nature of dependency. Since no definite structure is conveyed directly or indirectly from this limitation it is impossible to ascertain the scope of this claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22-26, 31-32, 35-38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Boardman et al (US 5 492 223).

Boardman et al disclose a workpiece carrier during the processing of the substrate (Abstract), a holder which receives and positions the substrate (Fig 6 and Col 7 first paragraph), base element (40), handling element (15"), carrier element (15) and covering element (10")

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located on the opposite side of the handling element (15), the covering element designed to position correctly on the handling element with inherent mechanical stops.

Since the added limitation of a first process step dependent covering element and a second process step dependent covering element does not narrate any structure, it is understood that this merely recites an intended use and is therefore not given any patentable weight.

Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

Claim 41 recites limitation of the apparatus holding a substrate during processing. However, expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

4. Claims 22-26, 31-32, 35-38 and 41 are rejected under 35 U.S.C. 102(a) as being anticipated by Troy Carter (US 5794783).

Troy Carter discloses a workpiece carrier during the processing of the substrate (Abstract), a holder which receives and positions the substrate (Fig 2-30), base element (21), handling element (27) and covering element (47) located on the opposite side of the handling element (Fig 2), the covering element designed to position correctly on the handling element with inherent mechanical stops.

Discussion regarding newly added limitation to claim 22 and claim 41 is stated above is not repeated here.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al (US 5 492 223) in view of Haas et al (US 5540334).

Boardman et al disclose a workpiece carrier during the processing of the substrate (Abstract), a holder which receives and positions the substrate (Fig 6 and Col 7 first paragraph), base element (40), handling element (15"), carrier element (15) and covering element (10") located on the opposite side of the handling element (15), the covering element designed to position correctly on the handling element with inherent mechanical stops.

Boardman et al disclose square structure but do not disclose hexagon structure associated with base element.

However the particular shape of the opening to hold articles is only related to the shape of the articles and convenience of placement and manufacturing.

Haas et al disclose a tray to carry articles and teach that shape of hole could be hexagonal among others (Col 3 lines 46-51).

Therefore having hexagonal structure for carrying base elements would have been obvious for one of ordinary skill in the art at the time of invention.

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7. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al (US 5 492 223) in view of Yoshiharu Takahashi (JP 10144824).

Boardman et al disclose a workpiece carrier during the processing of the substrate (Abstract), a holder which receives and positions the substrate (Fig 6 and Col 7 first paragraph), base element (40), handling element (15"), carrier element (15) and covering element (10") located on the opposite side of the handling element (15), the covering element designed to position correctly on the handling element with inherent mechanical stops.

Boardman et al do not disclose positioning elements in base element.

However positioning elements of tab and lug type are commonly known in the art.

Yoshiharu Takahashi discloses an arrangement of semiconductor elements held in a tray with groove and protrusion arrangement (Fig 1, 2 and 11).

Therefore it would have been obvious for one of ordinary skill in the art at the time of invention to have a positioning element like that of Takahashi to hold parts of different shapes in the holding element of Boardman et al.

8. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al (US 5 492 223) in view of Daniel J Friedman (EP 0844645).

Boardman et al disclose a workpiece carrier during the processing of the substrate (Abstract), a holder which receives and positions the substrate (Fig 6 and Col 7 first paragraph), base element (40), handling element (15"), carrier element (15) and covering element (10") located on the opposite side of the handling element (15), the covering element designed to position correctly on the handling element with inherent mechanical stops.

Boardman et al do not disclose coding arrangement for the parts.

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Daniel J Friedman discloses an arrangement of semiconductor elements held in a tray and arrangement of coding like bar code to keep track of their movement (Col lines 5-11, 35-40 and Col 2 lines 50-55).

Therefore it would have been obvious for one of ordinary skill in the art at the time of invention to have a coding arrangement for tracking purposes during processing.

Response to Amendment

Applicant's arguments filed 9/1/2004 have been fully considered but they are not persuasive.

Applicant argues that Boardman and Carter have nothing to do with a workpiece carrier for holding during processing of a substrate. This is not correct since Boardman discloses in tray inspection and testing and Carter discloses testing and burn-in.

Applicant argues that Haas is clearly a non-analogous art to both the claimed invention and claimed art.

The courts have held that the art is analogous when it solves the same problem as applicant. *In re Melin* 165 USPQ 168 (CCPA 1970) and art may be outside applicant's field of endeavor and still be analogous if both fields share the same common problem. *In re Nilssen* 7 USPQ 2d 1500 (Fed. Cir. 1988).

In this instance a hexagonal location hole is claimed to hold a hexagonal object. Haas discloses the same solution i.e., to have hexagonal hole in order to prevent movement.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram N Kackar whose telephone number is 571 272 1436. The examiner can normally be reached on M-F 8:00 A.M to 5:P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on 571 272 1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RK

*P. Hassanzadeh
primary Examiner
AU 1763*